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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,788	03/28/2001	Daniel J. Reese	10191/3242	2648
26646	7590	10/23/2009	EXAMINER	
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ONE BROADWAY				
NEW YORK, NY 10004			ART UNIT	PAPER NUMBER
			2621	
			MAIL DATE	DELIVERY MODE
			10/23/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL J. REESE,
DOUGLAS M. CAMENS, and PAUL J. BODELL

Appeal 2009-003172
Application 09/819,788
Technology Center 2600

Decided: October 23, 2009

Before KENNETH W. HAIRSTON, KARL D. EASTHOM,
and ELENI MANTIS-MERCADER, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1 to 20. We have jurisdiction under 35 U.S.C. § 6(b).

We will sustain the rejections.

Appellants' disclosed and claimed invention relates to a digital video recorder-controller (DVRC) apparatus, digital video system, and a method for expanding a digital video system (Abs.; claims 1, 12, and 17; Figs. 1 and 2). The system, method, and DVRC apparatus all include a network and a network port for communicating with another apparatus on the network (Abs.; Spec. 2-4; claims 1, 12, and 17). The DVRC apparatus (i) transmits a first selection of digitized video signals through the network port to a first other apparatus on the network, and (ii) receives a second selection of digitized video signals transmitted by a second other apparatus on the network through the network port (claim 1).

Claim 1 is representative of the claimed invention, and read as follows:

1. A digital video recorder-controller apparatus (DVRC) comprising:

a network port for communicatively connecting the DVRC with at least one other apparatus on a network;

wherein the DVRC is adapted to transmit through the network port a first selection of digitized video signals, wherein the first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network;

and wherein the DVRC is further adapted to receive through the network port a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network;

wherein the DVRC is adapted to facilitate designation of the digitized video signals of the second selection.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lang	US 4,963,995	Oct. 16, 1990
Osakabe	US 5,666,363	Sep. 9, 1997
Teng	US 5,930,473	Jul. 27, 1999
Arazi	US 6,330,025 B1	Dec. 11, 2001

(i) The Examiner rejected claims 1 to 6, 10, 11, 17, and 18 under 35 U.S.C. § 102(b) based upon the teachings of Lang.

(ii) The Examiner rejected claim 7 under 35 U.S.C. § 103(a) based upon the teachings of Lang and Teng.

(iii) The Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a) based upon the teachings of Lang and Osakabe.

(iv) The Examiner rejected claims 12 to 16 and 19 under 35 U.S.C. § 103(a) based upon the teachings of Lang and Arazi.

(v) The Examiner rejected claim 20 under 35 U.S.C. § 103(a) based upon the teachings of Lang, Arazi, and Osakabe.

In establishing a prima facie case of anticipation under § 102(b) (rejection (i) *supra*), as well as obviousness under § 103(a) (rejections (ii) through (v) *supra*), the Examiner relies upon Lang as teaching a DVRC including a network port 22 for (i) transmitting a first selection of digitized video signals to a first other apparatus, and (ii) receiving a designated second selection of digitized video signals from a second other apparatus (Ans. 3-5).

The Examiner determines (Ans. 3, 5, 8, and 12-13) that Lang's elements 22 and 46 are a network port.

FINDINGS OF FACT (FF)

1. Appellants describe a DVRC 200 including a network port for connection to a network (*see* Fig. 2; Spec. 2:10 to 4:3). The DVRC 200 can communicate through the network port with other DVRCs (*see* DVRC-1 through DVRC-N in Fig. 1).
2. Appellants disclose that the network may be an Ethernet network (Spec. 4:5, 13; Spec. 5:1-6; Spec. 13:11-12). Appellants also disclose that “the network need not be limited to an ‘ethernet’ network, but may be of *any other known* or future digital network technology having sufficient bandwidth and being otherwise *capable of transmitting* the digital video signals and control signals” (Spec. 15:16-19) (emphasis added).
3. Lang describes an audio/video recorder transmitter-editor 10 (VCR-ET) with a digital control unit 14, audio/video transmitter/receiver 22 with keypad 45, and output port 46 for connection via modem to other VCR-ETs (Figs. 1, 2; col. 8, ll. 20-50; col. 9, l. 31 to col. 10, l. 21). “Output port 46 of transmitter/receiver 22 connects directly to the telephone line” (col. 8, ll. 49-50).
4. Lang describes transmitting digitized video signals from VCR-ET 10 to another VCR-ET over a phone line via port 46 (col. 8, ll. 29-50; col. 9, l. 55-68). A destination phone number may be entered using keypad 45 (col. 8, ll. 46-47).

5. Lang describes that VCR-ET 10 may also receive selected digitized video signals from a remote VCR-ET through port 46 (col. 10, ll. 14-16), the selection being made by digital control unit 14 which can edit and select the video signals/frames as desired by the user (col. 6, ll. 23-42; col. 9, ll. 31-54). A digitized program of video signals may be stored in a memory 13 “either in its entirety or in random segments, based on user preference” (col. 10, ll. 4-5), and these video signals may be received by one VCR-ET from another VCR-ET over the phone line through port 46 and transmitter/receiver 22 (col. 10, ll. 14-20).
6. Osakabe describes a bi-directional bus system (Figs. 6, 7) for transmitting video signals and control signals between plural video tape recorders 20/30 and video deck players 40 over a bi-directional bus 1 (*see Abstract*; col. 6, ll. 54-58; col. 7, l. 14 to col. 8, l. 14). Osakabe describes a master-slave relationship between the plural video devices using a “control command” including a master address field 102, slave address field 103, control field 104, and data field 105 (Figs. 1-3, 9; col. 1, l. 49 to col. 2, l. 31).

ISSUES

Anticipation

With regard to the anticipation rejection of independent claims 1 and 17 and dependent claims 2 to 6, 10, 11, and 18, Appellants argue, *inter alia*, (App. Br. 5-8; Reply Br. 2-5) that Lang fails to teach or suggest a network port for transmitting and receiving first and second selections of digitized

video signals to respective first and second other apparatuses on the network, as set forth in claim 1.

Based on Appellants' arguments, the following anticipation issue is presented: Have Appellants shown that the Examiner erred in determining that Lang teaches a network port for connection to a network, as set forth in independent claim 1?

Obviousness

With regard to the obviousness rejection of independent claim 12 and dependent claims 7 to 9, 13 to 16, 19, and 20, Appellants argue, *inter alia*, (App. Br. 8-12; Reply Br. 6-9) that Lang, taken singly or in combination, fails to teach or suggest the network and network port recited in these claims. In other words, Appellants contend that none of the secondary references cures the deficiencies of Lang. *Id.* With regard to claims 8 and 9, Appellants contend (App. Br. 10; Reply Br. 6-7) that (i) Osakabe fails to teach the first control signal, and (ii) there is no motivation to combine Osakabe with Lang because Lang has no possibility of external control. With regard to claims 12 to 16, 19, and 20, Appellants contend (App. Br. 11-12; Reply Br. 7-9) that there is no motivation to combine Arazi with Lange because Lang deals with only one data source as opposed to several.

Based on Appellants' arguments, the following obviousness issue is presented: Have Appellants shown that the Examiner erred in determining that Lang and the various secondary references (Teng, Osakabe, and Arazi), taken singly or in combination, teach or suggest the DVRC apparatus, system, and method, as set forth in claims 7 to 9, 12 to 16, 19, and 20?

PRINCIPLES OF LAW

Claim Construction

“During examination, ‘claims … are to be given their broadest reasonable interpretation consistent with the specification, and … claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech. Cir.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997).

Anticipation

Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Obviousness

Appellant has the burden, when on appeal to the Board, to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellant has the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Anticipation Rejection of Claims 1 to 6, 10, 11, 17, and 18

Representative claim 1 recites a DVRC having “a network port for communicatively connecting the DVRC with at least one other apparatus on

a network” (claim 1). The DVRC transmits and receives digitized video signals to and from first and second other apparatuses on the network (*see* claim 1).

Broadly interpreted, claim 1 only requires a DVRC with a network port for connecting to other devices over a network. *See Am. Acad. of Sci. Tech. Cir.*, 367 F.3d at 1364. The phrase “network” broadly encompasses a point-to-point or telephone connection between two devices, especially such a connection which allows for transmission of digitized video signals.

The Examiner is correct that port 46 is a network port and the telephone line and modem connection between devices is a network since the lines making the connection transmit digital video signals and control signals between devices (Ans. 12-13; Final Rej. 12; Advisory Action 3). This is especially true in view of Appellants’ description of a “network” in the Specification as any known technology capable of transmitting digital video and control signals (FF 2).

Appellants’ argument that one of skill in the art would interpret the term “network” as being synonymous with “Ethernet network” instead of “point-to-point network” is unconvincing (Reply Br. 4-5). A proper interpretation of claim 1, giving the claim its broadest reasonable interpretation consistent with the Specification as understood by one of ordinary skill in the art (*Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), has to rely on the meaning of “network” defined in the originally filed Specification (FF 2). Appellants can be their own lexicographer, and choose the words to be used in the claims. However, Appellants have chosen to broaden the scope of the claims by using the term “network” in the claims, and not “Ethernet network” (*see* claims 1, 12).

Appellants' contention (App. Br. 6-7; Reply Br. 5) that Lang fails to teach a network port because element 22 is an audio/video transmitter/receiver or modem for conventional telephone connection is unpersuasive because (i) Lang's output port 46 operates in cooperation with modem 22 as a port to connect the VCR-ET to other VCR-ETs (FF 3, 4), (ii) the Examiner relies on column 8, lines 28 to 50; column 9, lines 60 to 69; and column 10, lines 14 to 20 which describe *both* elements 22 and 46 as teaching a network port (*see* Ans. 12), and (iii) Lang discloses that the transmitter/receiver 22 *includes* the output port 46 (FF 3). Therefore, the Examiner's reliance upon element 22 as being a network port is correct inasmuch as element 22 includes output port 46, and elements 22 and 46 together perform the function of a network port.

Appellants' arguments (App. Br. 7-8; Reply Br. 3-4) that Lang neither enables nor teaches the limitation of claim 1 that "the DVRC is adapted to facilitate designation of the digitized video signals of the second selection" are unpersuasive. Lang describes receiving a DVRC 10 for receiving a second selection of digitized video signals (e.g., the video signals are selected either in their entirety or in random segments using digital control unit 14) through port 46 from another DVRC (FF 5).

Thus, we find no error in the Examiner's reliance on Lang as teaching or suggesting a digital video device including a network port for connecting to other digital video devices on a network (*see* Ans. 3-4; FF 3-5), at least to the extent this feature is broadly claimed. *See Am. Acad. of Sci. Tech. Cir., supra.* Appellants have not shown that the Examiner erred in determining that Lang teaches a network port for connection to a network, as set forth in independent claim 1. Accordingly we will sustain the Examiner's

anticipation rejection of claim 1. Because (i) Appellants only present nominal arguments as to claims 2 to 6, 10, 11, 17, and 18 (App. Br. 8; Reply Br. 6), (ii) claim 17 contains features similar to claim 1, and (iii) for similar reasons as discussed with respect to claim 1, we will also sustain the Examiner's anticipation rejection of claims 2 to 6, 10, 11, 17, and 18.

Obviousness Rejections of Claims 7 to 9, 12 to 16, 19, and 20

Turning next to the obviousness rejections of independent claim 12 and dependent claims 7 to 9, 13 to 16, 19, and 20, we find that Appellants have not persuasively rebutted the Examiner's prima facie case of obviousness for these claims (*see* Ans. 4-11). *Kahn*, 441 F.3d at 985-86; *Oetiker*, 977 F.2d at 1445.

As indicated *supra*, Appellants argue that (i) Lang fails to teach or suggest the network and network port recited in these claims for similar reasons as argued with respect to claim 1, and (ii) that none of the secondary references to Teng, Osakabe, and Arazi cures the deficiencies of Lang. Appellants' arguments are unpersuasive in light of our findings concerning Lang (i.e., Lang teaches all of the limitations of claim 1 of a DVRC apparatus having a network port for connecting to other devices on a network) (*see* FF 3-5).

With regard to claims 8 and 9, Appellants' contention (App. Br. 10; Reply Br. 6-7) that (i) Osakabe fails to teach the first control signal, and (ii) there is no motivation to combine Osakabe with Lang because Lang has no possibility of external control is unconvincing. Osakabe describes a bi-directional bus system for transmitting video signals and control signals between plural video tape recorders 20/30 and video deck players 40 over a bi-directional bus 1 (FF 6). Osakabe also describes a master-slave

relationship between the plural video devices using a “control command” including a master address field 102, slave address field 103, control field 104, and data field 105 (FF 6). The Examiner has provided a reason for combining the teachings of Osakabe with those of Lang (i.e., generating control signals from one apparatus to another to enhance functionality) (Ans. 7). Appellants have not adequately shown otherwise.

With regard to claims 12 to 16, 19, and 20, Appellants’ contention (App. Br. 11-12; Reply Br. 7-9) that there is no motivation to combine Arazi with Lang because Lang deals with only one data source as opposed to several is unconvincing. Arazi describes plural data sources and the Examiner has provided a reason for combining the teachings of Arazi (i.e., plural video cameras) with those of Lang (i.e., receiving video information from plural cameras to enhance the capacity of Lang’s digital video recorder by receiving additional video sources for recording) (Ans. 9). Appellants have not adequately shown otherwise.

Appellants have not shown that the Examiner erred in determining that Lang and the various secondary references (Teng, Osakabe, and Arazi), taken singly or in combination, fail to teach or suggest the DVRC apparatus, system, and method, as set forth in claims 7 to 9, 12 to 16, 19, and 20.

For all of the foregoing reasons, we sustain the Examiner’s obviousness rejections of claims 7 to 9 and 12 to 16 which are based on the teachings of Lang (*see* rejections (ii) through (iv) *supra*) for similar reasons as claim 1. Appellants present no substantive arguments concerning the obviousness rejections of claims 19 and 20 (*see* rejections (iv) and (v) *supra*), and rely on the arguments for the patentability of claims 1 and 17 discussed *supra* (*see* App. Br. 11-12). We therefore sustain the Examiner’s

Appeal 2009-003172
Application 09/819,788

rejection of (i) claim 19 over Lang and Arazi, and (ii) claim 20 over Lang, Arazi, and Osakabe for the same reasons as those provided with respect to claims 1 and 17.

CONCLUSIONS OF LAW

(i) Appellants have not shown that the Examiner erred in determining that Lang teaches a network port for connection to a network, as set forth in independent claim 1. Accordingly, we conclude that Appellants have not shown the Examiner erred in rejecting claims 1 to 6, 10, 11, 17, and 18 under 35 U.S.C. § 102(b).

(ii) Appellants have not shown that the Examiner erred in determining that Lang and the various secondary references (Teng, Osakabe, and Arazi), taken singly or in combination, teach or suggest the DVRC apparatus, system, and method, as set forth in claims 7 to 9, 12 to 16, 19, and 20. Accordingly, we conclude that Appellants have not shown the Examiner erred in rejecting claims 7 to 9, 12 to 16, 19, and 20 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner rejecting claims 1 to 20 is affirmed.

Appeal 2009-003172
Application 09/819,788

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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